

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

The examiner objected to claims 5 and 33 because of informalities. Claims 5 & 33 have been amended to address the Examiner's concerns, making the objection moot.

Claims 1-4, 6-34, 36, 39, 40 & 42 were rejected under 35 U.S.C. §103(a) as being unpatentable over Shapiro (U.S. 5,705,980) in view of Balachandran (U.S. 6,073,004). Claims 5, 41, 43, and 45 were rejected as above in combination with Alperovich *et al.* (U.S. 6,078,804). Claims 37 & 38 were rejected as being unpatentable over Alperovich in view of Pecan *et al.* (U.S. 6,466,804). For the following reasons, the rejections are respectfully traversed.

Claim 1, as amended, recites a method for distributing an emergency call message within a telecommunication network with the steps of "determining a first set comprising one or more terminals" and "determining a second set comprising one or more terminals". Neither of the references suggest determining both a first and second set of terminals as recited in claim 1.

Further, claim 1 recites the step of "generating an emergency call message to the terminals of said first set" and, if no terminal of said first set "acknowledges said emergency call", then performing the step of "automatically sending said emergency call message to said terminals of said second set" wherein "said terminals of one of said first set and said second set are mobile devices part of the communication network that are in a vicinity closest to said mobile user" and further wherein "said terminals of the other of said first set and said second set are terminals predefined by said user". Thus, the criteria for choosing the two sets is different.

In contrast, the Examiner states that Shapiro teaches sending an emergency call message first to police officers that are in the area of the emergency situation, and then transmitting the message to the next closest officer. Nowhere does Shapiro suggest that one set of terminals are in a vicinity closest to the user whereas a second set of terminals are predefined by the user.

Balachandran teaches sending messages to a predetermined base station, not a mobile

device (see FIG. 1 and accompanying text). Further, Balachandran does not suggest contacting a first set of terminals, and then a second set, as recited in the claim. Hence, Balachandran cannot be used to overcome the shortcomings of the Shapiro reference. Thus, claim 1 is patentable over the combination, because neither references suggest the contacting the first set, and then the second set, as recited in claim 1.

Further, the Examiner has failed to provide the proper motivation for the combination. The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to modify the reference (MPEP §2143.01). The mere fact that references *can* be combined or modified, alone, is not sufficient to establish prima facie obviousness (*Id.*). The prior art must also suggest the *desirability* of the combination (*Id.*). The fact that the claimed invention is within the *capabilities* of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (*Id.*).

The Examiner has still not cited any support for any such suggestion or motivation for the combination from within the references, and neither does the Examiner provide any references supporting any motivation to modify the reference(s) by making the combination. A conclusory statement of benefit, such as the one provided by the Examiner in the Office action, is not sufficient to show obviousness.

Merely listing an advantage of the combination is also not sufficient, as some rationale for combining the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP §2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

“To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention ‘*as a whole*’ would have been obvious at that time to that person.” (MPEP §2142, emphasis added). It is not proper to

merely combine various elements from various references. The invention must be obvious "as a whole", not piecemeal. Thus, the combination is improper.

Further, the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. MPEP § 2143.01. In this case, the Balachandran reference is activated by sensors that detect an automobile accident, and uses a mobile telephone network. In contrast, Shaprio uses a dedicated network, not a mobile telephone network, and is manually activated. Combining with Shapiro to attempt to arrive at the invention would change this principle of operation of one or the other references, which is not proper. Thus, the combination is not permitted.

Neither Alperovich nor Pecen overcome the above shortcomings discussed for the claim 1 rejection. Accordingly, claims 2-39, which depend, directly or indirectly, on claim 1, are hence patentable for at least the same reasons as claim 1.

Further, the Examiner blanketly states that many features that are not taught by the references would be "obvious" to add because they provide some benefit, and the Examiner takes official notice to that effect. Applicant traverses these assertions. The Examiner cites various references for teaching various features to support an assertion of "official notice", without providing any motivation or reasoning for adding those features to the base reference. Applicant does not dispute that the claimed features provide some benefit. The problem is that the Examiner has not shown, sufficient to the required legal standards (i.e., providing proper motivation) that it would be obvious to add these features to the base references. Thus, even if a feature is known for some other use or application, the Examiner must provide some motivation or reasoning for adding that feature to the base references. Thus, the features are not properly combined with the base references absent this required motivation, and thus the combinations are improperly used to reject the claims.

Further still, Claim 40 recites "automatically sending the emergency call message first to one or more arbitrary mobile devices in a vicinity closest to the mobile user" and then "distributing the emergency call message to terminals predefined by said user". Neither reference suggest sending an emergency call message to one or more *arbitrary* mobile devices in a vicinity closest to the mobile user. Shapiro teaches sending messages only to *police officers* and uses a dedicated network, not a telecommunication network having arbitrary mobile devices. Thus, Shapiro does not teach sending messages to "arbitrary" mobile devices, which might be to a private citizen closer to the emergency than the closest

police officer, for example. Balachandran sends messages to a base station, not a mobile device. Accordingly, the invention as defined by claim 40 is patentable over the references, even if combined. Alperovich does not overcome the above shortcomings, thus claim 41, which depends on claim 40, is at least patentable over the references for the same reason.

Claim 42 also recites "sending the emergency call message first to one or more arbitrary mobile devices in a vicinity closest to the mobile user" and thus is patentable over the references for the reason discussed for claim 40, above. Alperovich does not overcome the above shortcomings, thus claim 43, which depends on claim 42, is patentable over the references for at least the same reasons as claim 42.

Claim 44 recites "automatically sending the emergency call message first to one or more arbitrary mobile devices part of the communication network that are geographically closest to the mobile user" and then "distributing the emergency call message to terminals predefined by said user". Thus, claim 44 is patentable over the references for the same reasons discussed for claim 40, above. Alperovich does not overcome the above shortcomings, thus claim 45, which depends on claim 44, is patentable over the references for at least the same reasons as claim 44.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 34378.

Respectfully submitted,

PEARNE & GORDON, LLP

By: 

Robert F. Bodi, Reg. No. 48,540

1801 East 9th Street, Suite 1200
Cleveland, Ohio 44114-3108
(216) 579-1700

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